REMARKS

There are now pending in this application Claims 1, 3, 4, 7, 9-12, 27-29, 31-33, 38, and 42-53, with Claims 1, 27-29, 31, 38, 42, 46, 48, and 51 being the independent claims. Claims 16-18, 26, 34, 35, 37, and 39-41 have been cancelled. Claims 1, 3, 4, 7, 27-29, 31-33, and 38 have been amended. Claims 42-53 are newly-presented.

Support for the newly-presented claims may be found, for example, inter alia at page 4, line 6 of the specification.

In the Official Action, dated September 25, 2002, Claims 1, 3, 4, 7, 9-13, 16-18, 22, 23, 26-32, and 38-40 were rejected under 25 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,029, 182 (Nehab, et al.) in view of U.S. Patent No. 5,796,952 (Davis, et al.) .

However, Applicants note that the Examiner has also cited "Judson" and "Yoda" at pages 4-7 of the Official Action. For the purpose of responding to the aforementioned Official Action, Applicants presume that the reference to "Judson" is to U.S. Patent 5,737,619 (Judson) and the reference to "Yoda" is to U.S. Patent No. 5,890,173 (Yoda). Applicants respectfully request confirmation that this presumption is accurate.

Additionally, it is Applicants understanding that the references to the Judson patent at page 5, lines 3, 9, 13, 16 and 21 and at page 6, lines 1 and 5 should, in fact, be references to the Yoda patent. Applicants request clarification regarding whether this understanding is correct.

In the Official Action, Claims 33-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nehab in view of Davis, and further in view of U.S. Patent No. 5, 633,996 (Hayashi, et al.).

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Reconsideration and withdrawal of these aforementioned rejections are respectfully requested in view of the above-amendments and the following remarks.

Claim 1 relates to a method, operable in a first application upon a local machine, of forming a single continuous printable document by collating a plurality of hyper-text documents. The method comprises the steps of monitoring a second application operating independently of the first application on the local machine, to identify access patterns of the second application to the plurality of hyper-text documents; accessing the plurality of hyper-text documents including formatting information of the accessed hyper-text documents; compiling a list of the plurality of accessed hyper-text documents using the formatting information; fetching a selected the plurality of accessed hyper-text documents compiled to the list; and formatting the plurality of fetched hyper-text documents using the formatting information into the single continuous printable document in which at least one said fetched hyper-text document is spatially contiguously followed by another said fetched hyper-text document on the same page of said single continuous printable document.

Claim 1 has been amended to recite that the second application operates independently of the first application on the local machine. This arrangement permits the first application, such as a collating program, to operate independently of a second application, such as a browser program, and to form a printable document that represents the accesses performed by the browser program. Accordingly, a single machine (ie, the local machine) can have operating upon it two independent application programs, one of which monitors the operations of the other.

The cited art fails to disclose or suggest the above-mentioned features of the present invention. In particular, the cited art fails to disclose or suggest a method, operable in a

first application upon a local machine, of forming a single continuous printable document by collating a plurality of hyper-text documents using several steps, including, inter alia, monitoring a second application operating independently of the first application on the local machine, to identify access patterns of the second application to the plurality of hyper-text documents.

The Nehab, et al. patent relates to a system for generating a custom formatted hypertext document by using a personal profile to retrieve hierarchical documents. However, this patent fails to disclose or suggest monitoring a second application operating independently of the first application on the local machine, to identify access patterns of the second application to the plurality of hyper-text documents, as claimed in Claim 1.

The Davis, et al. patent relates to a method for monitoring client interaction with a network resource and creating client profiles and a resource database. However, this patent fails to disclose or suggest monitoring a second application operating independently of the first application on the local machine, to identify access patterns of the second application to the plurality of hyper-text documents, as claimed in Claim 1.

In Davis, the user using a browser accesses a resource from a network such as the World Wide Web. Upon accessing the particular resource, the server providing the resource also delivers to the user a monitoring program which monitors the user's interaction with the resource. The monitoring program returns information to the server by which the server may determine other resources of preference that may be subsequently delivered to the user. Applicants submit that in the arrangement described in the Davis patent, the monitoring program is associated with the particular resource delivered to the client via the server. The server, being the provider of both the resource and the monitoring program, can tailor the monitoring program

to operate in consert with the resource. Accordingly, the monitoring program and the delivered resource are not independent of one another, but rather are linked to one another.

Accordingly, Applicants submit that Claim 1 is allowable over the cited art.

Moreover, the cited patents fail to disclose or suggest, either alone or in combination, at least one feature of each of independent Claims 27, 28, 29, 31, 38, 42, and 46 (Claim 27–"the method being operable in a first application upon a local computer, the documents being obtained from a plurality of sources by a second application independently operable from the first application upon the local computer"; Claim 28–"means, operable in the local computer, for independently monitoring the accessing of the plurality of documents via the resource locater and for compiling a list of the accessed plurality of documents"; Claim 29–"printing a single continuous document composed of a plurality of documents derived by a second computer program from a plurality of sources in a network, the first computer program being operable independently of the second computer program"; Claim 31–"the computer program being operable upon a local computer independently of a browser program by which the hyper-text documents are accessible"; Claim 38–"the second application "monitoring access patterns of the first application to the plurality of hyper-text documents independently of operation of the first application"; Claim 42–"monitoring a second application, operating independently of the first application on the local machine, to identify access patterns of the second application to the plurality of documents"; Claim 46–"code for monitoring a second application operating independently of the first application on the local machine, to identify access patterns of the second application to the plurality of documents").

Thus, independent Claims 27, 28, 29, 31, 38, 42, and 46 are also allowable over the cited patents.

Newly-presented Claim 48 relates to a method of forming a single continuous printable document by collating a plurality of documents. The method comprises the steps of monitoring a user's access patterns to the plurality of documents; compiling a list of the plurality of accessed documents, based on monitoring of the user's access pattern to the document in the monitoring step; displaying the list of the plurality of accessed documents for enabling selection of at least one of the documents to be printed; and formatting each document selected from the list into the single continuous printable document in which at least one selected document is contiguously followed by another selected document on the same page of the single continuous printable document.

However, the cited references fail to disclose or suggest the above-referenced features of the present invention as described in Claim 48. In particular, the cited references, either alone or in combination, fail to disclose or suggest displaying the list of the plurality of accessed documents for enabling selection of at least one of the documents to be printed; and formatting each document selected from the list into a single continuous printable document in which at least one selected document is contiguously followed by another selected document on the same page of the single continuous printable document.

The Nehab patent discloses a container 76 that stores URL address data of selected documents. When a user clicks on an icon of the container 76, a menu 77 is displayed. The menu 77 provides five options (Open 79, Empty 80, Print 81, Edit 82, and Save 84). When activated, the option Open 79 displays the Container Contents screen 87 shown in Figure 9B of the patent. The Container Contents screen 87 shows the URL addresses stored in container 76. Applicants submit that in Nehab a user may add and delete a desired URL to and from the

container 76. However, the user cannot select a URL in container 76 to create a single continuous printable document.

Accordingly, Applicants submit that Claim 48 is allowable over the cited art.

Claim 51 relates to a computer program product and corresponds generally to Claim 48. As such, Claim 51 is allowable for the same reasons.

The dependent claims depend from one or another of the independent claims and are believed allowable for the same reasons. Moreover, each of these dependent claims recite additional features in combination with the features of their respective independent claims and is believed allowable in its own right. Individual consideration of the dependent claims respectfully is requested.

Applicants believe that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action and submit that the application is in condition for allowance. Favorable consideration of the claims and early passage to issue of the present application earnestly are solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

By: _Shawn W. Fraser_____
Attorney for Applicants
Shawn W. Fraser
Registration No. 45,886

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile No.: (212) 218-2200

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MARKED-UP VERSION SHOWING CHANGES TO THE CLAIMS

1.   (Five Times Amended) A method, operable in a first application upon a local machine, of forming a single continuous printable document by collating a plurality of hyper-text documents, said method comprising the steps of:

[(a)]   monitoring a second application operating independently of said first application on said local machine, to identify [a user's] access patterns of the second application to the plurality of hyper-text documents;

[(b)   from said monitoring,] accessing the plurality of hyper-text documents and [including] formatting information of the [accessed] plurality of hyper-text documents;

[(c)]   compiling a list of the plurality of accessed hyper-text documents using the formatting [structure] information;

[(d)]   fetching [a selected] the plurality of [the] accessed hyper-text documents compiled to the list; and

[(e)] formatting the plurality of fetched hyper-text documents using the formatting information into [a] the single continuous printable document in which at least one said fetched hyper-text document is spatially contiguously followed by another said fetched hyper-text document on the same page of said single continuous printable document.

3.   (Twice Amended) A method as claimed in Claim 1, wherein the printable document is updated upon new hyper-text pages being accessed by the second application.

4.   (Twice Amended) A method as claimed in Claim 1, wherein said steps are performed <u>by said first application</u> in a background mode relative to [the user's] access to the hyper-text documents <u>by the second application</u>.

7.   (Twice Amended) A method as claimed in Claim 1, wherein [step (d)] <u>the formatting step</u> [comprises the steps of formatting] <u>formats</u> the printable document for multiple column page printing on a printer output device.

Claims 16-18 are cancelled herein.

Claim 26 is cancelled herein.

27.   (Four Times Amended) A computer implemented method for forming a single continuous printable document by collating a plurality of documents<u>, said method being operable in a first application upon a local computer, said documents being</u> obtained from a plurality of sources <u>by a second application independently operable from said first application upon said local computer</u>, said method comprising the steps of:

monitoring accesses <u>by the second application</u> to the plurality of documents in sequence;

recording the contents of a plurality of selected [ones of the] documents including formatting information relating to each selected document; and

collating the plurality of selected documents according to a predetermined order

of collation to form the single continuous printable document, said collating step comprising the

step of arranging at least one display page displaying a plurality of the selected [ones of the]

documents according to a size of each selected document based upon the corresponding

formatting information and with at least one said selected document being spatially contiguously

followed by another said selected document, wherein the printable document is reproducible at

least by printing.

28.   (Three Times Amended) A computer system comprising:

a network comprising a source of a plurality of documents each individually

accessible via a corresponding resource locater and in which the plurality of documents include

therein links that afford access to [others of the] a plurality of [the] other documents;

means, operable in a local computer, for accessing the plurality of documents;

means, operable in said local computer, for independently monitoring [access to]

said accessing of the plurality of documents via said resource locater and for compiling a list of

the accessed [ones of the] plurality of documents, the list including the [corresponding] links and

formatting information pertaining to each accessed document; and

means, operable in said local computer, for collating the plurality of accessed

documents represented in the list into a selected order and for formatting the [accessed] plurality

of accessed documents within the list using the formatting information into a single continuous

printable document having at least components corresponding to the [accessed] plurality of

accessed documents arranged in the selected order and in which at least one said accessed

document is spatially contiguously followed by another said accessed document on the same

page of said single printable document.

29.   (Four Times Amended) A computer readable medium <u>having first</u>

<u>computer program</u> [including] instruction modules arranged <u>to make a computer execute a</u>

<u>procedure</u> to collate for printing a single continuous document composed of a plurality of

documents derived <u>by a second computer program</u> from a plurality of sources in a network, <u>said</u>

<u>first computer program being operable independently of the second computer program,</u> said

modules comprising:

a monitoring module for monitoring browsing operations <u>performed by the second</u>

<u>computer program</u> throughout the network;

a compiling module for compiling a list of [a selected] <u>the</u> plurality of documents

and corresponding formatting information encountered during the browsing operations;

a collating module for collating [user selected ones of] the plurality of documents

from the list into a single continuous printable document in which each [selected] document is

formatted according to corresponding formatting information derived during the monitoring and

at least one [said selected document] <u>of the plurality of documents</u> is spatially contiguously

followed by another <u>one of the plurality of documents</u> [said selected document] on a page of said

single continuous [printable] document; and

a printing module for causing a printing of the single continuous [printable]

document thereby causing hard copy reproduction of the [selected] <u>plurality of</u> documents and

causing said <u>at least</u> one <u>of the plurality of documents</u> and <u>said</u> another <u>one of the plurality of</u>

[selected] documents <u>to be printed</u> on one page [thereof].

31.   (Three Times Amended) A computer program product having a computer

readable medium having a computer program recorded thereon for forming a printable document

by collating a plurality of hyper-text documents, <u>said computer program being operable upon a</u>

<u>local computer independently of a browser program by which said hyper-text documents are</u>

<u>accessible,</u> said computer program product comprising:

means for monitoring [a user's] access patterns <u>of said browser program</u> to the

plurality of hyper-text documents;

means for accessing the plurality of hyper-text documents [including] <u>and</u>

formatting information of the accessed hyper-text documents;

means for compiling a list of [selected ones of] the plurality of hyper-text

documents using the formatting information;

means for fetching [a selected] <u>the</u> plurality of [the] accessed hyper-text

documents compiled in the list; and

means for formatting the plurality of accessed hyper-text documents using the

formatting information into a single continuous printable document comprising the [selected

ones] <u>plurality</u> of [the] accessed hyper-text documents in which at least one said accessed hyper-

text document is spatially contiguously followed by another said accessed hyper-text document

on the same page of said single continuous printable document.

32.   (Amended) A method as claimed in Claim 7, wherein <u>the formatting step</u> [step (d) comprises the step of maximizing] <u>maximizes</u> the number of the hyper-text documents on each page of the <u>single continuous</u> printable document.

33.   (Amended) A method as claimed in Claim 32, wherein [step (d) comprises the steps of formatting] <u>the formatting step formats</u> each hyper-text document according to a predetermined printable document format, determining if space exists on a page of the <u>single continuous</u> printable document for a formatted hyper-text document and, if so, inserting the formatted hyper-text document into the <u>single continuous</u> printable document and, if not, creating a further page in the <u>single continuous</u> printable document and inserting the formatted hyper-text document into the further page.

Claims 34, 35, and 37 are cancelled herein.

38.   (Twice Amended) A computer implemented method for forming a single continuous printable document by collating a plurality of hyper-text documents, said method comprising the steps of:

[(a)]   initiating a first application <u>on a local computer</u> for accessing and browsing <u>the</u> [a] plurality of hyper-text documents;

[(b)]   initiating a second application <u>on said local computer</u>, said second application <u>comprising the steps of</u>:

[(1)]   monitoring access patterns of the first application <u>to the plurality of</u>

<u>hyper-text documents independently of operation of the first application</u>;

[(2)]   fetching [a] <u>the</u> plurality of hyper-text documents accessed by the

first application [including] <u>and</u> corresponding formatting information of the [accessed] plurality

of hyper-text documents; and

[(3)]   creating a formatted single continuous printable document version

of the plurality of fetched hyper-text documents using the formatting information in which at

least one said fetched hyper-text document is spatially contiguously followed by another said

fetched hyper-text document on the same page of said single continuous printable document.

Claims 39-41 are cancelled herein.

MARKED-UP VERSION SHOWING CHANGES TO THE SPECIFICATION

Please substitute the paragraph beginning at page 4, line 6 and ending at line 16, as follows.

--The preferred embodiment of the present invention is described as a computer application program hosted on the Windows™ operating system developed by Microsoft Corporation. However, those skilled in the art will recognise that the described embodiment may [can] be implemented on computer systems hosted by other operating systems. For example, the preferred embodiment can be performed on computer systems running UNIX™, OS/2™, DOS™. The application program has a user interface which includes menu items and controls that respond to mouse and keyboard operations. The application program has the ability to transmit data to one or more printers either directly connected to a host computer or accessed over a network. The application program also has the ability to transmit and receive data to a connected digital communications network (for example the "Internet").--

Please substitute the paragraph beginning at page 4, line 17 and ending at line 26, as follows.

--A high-level block diagram is illustrated in Fig. 1 to provide an overview of the preferred embodiment. A Hyper-text browser 10 is provided to an output to a display device 11 for viewing hyper-text documents. Typically, the hyper-text browser 10 is of the form of application software implemented on a general purpose computer system (eg. IBM PC or

compatible, Apple Macintosh, Sun-Workstation etc.) and hyper-text documents includes images,

linked documents and simple TEXT documents. Current examples of the hyper-text browser

include Microsoft Explorer and NETSCAPE. The computer system (not shown in Fig. 1) usually

forms an interface which connects a network system 12 of computers to the display device 11

and to a print output device 13.--